

REMARKS

Claims 30-39, 41-50, 56, 57, 60-64, 107, 108, and 111-120 are pending in the present application.

In summary of the outstanding Office Action , claims 111-113, 116-118 and 120 stand rejected under 35 U.S.C. § 112. Claims 56, 107, 111, 119, and 120 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,619,247 to Russo. Claims 30, 31, 34-38, 43, 44, 50, 113-115, and 118 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. Claims 47-49 are rejected under 35 U.S.C. as being unpatentable over U.S. Patent 5,619,247 to Russo, WO 92/22983 to Browne et al. and U.S. Patent 6,249,532 to Yoshikaw et al. in view of U.S. Patent 5,905,713 to Anderson et al. Claims 33, 41, 45, and 116 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 6,177,931 to Alexander et al. Claims 39 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 6,522,769 to Rhoads et al. Claims 57, 60, 108, and 112 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,734,720 to Salganicoff. Claims 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of WO 92/22983 to Browne et al. Claim 117 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. in view of U.S. Patent 5,483,278 to Strubbe et al.

Reconsideration of the outstanding objections and rejections to the claims is respectfully requested in view of the present amendments and following remarks.

Rejections under 35 USC § 112

Claims 111-113, 116-118 and 120 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement.

Regarding claims 111 and 112, the Office Action States "...the mechanism that automatically selects from the digital data content, makes said selection (of digital content)

before the transmission and not after all of said digital data content is received at the user station as recited in the claim.” The Office Action comes to this conclusion by relying on a portion of the patent application specification that describes the ID headers being read “on all of the broadcast movies and select for downloading to module 230 only those that are indicated as being desirable to the customer...” (page 22, lines 45-47). However, Applicants note that the broadcast content is actually described in the specification as being received at the user station at the download module 220 before being selected (automatically or otherwise) for storage in the storage module 230. Below are excerpts from the specification that provide support for this aspect of the invention.

“The digital video content and program/pricing information, once received by the appropriate satellite, are then transmitted down broadly (i.e., “blanket transmitted”) to geographic coverage areas where the user stations can receive the downlink transmissions via the user’s satellite dish 24. Data is then transmitted to download module 220 contained in user station 228 where it is decoded and stored digitally in the storage module 230, preferably on a large disk drive...”

Specification page 35, lines 2-11, Fig. 11.

As shown in Fig. 11, the download module 220 has a high speed memory buffer in which digital content is stored prior to being selected for storage in the separate storage module 230 to which the Office Action refers. Download module 220 also appears in Fig. 15 which corresponds to the description of the automatic selection as recited in claims 111 and 112. Thus, although the specification describes the headers of the broadcasted received digital data content being read in order for the automatic selection to take place, this is after digital data content has been received (along with the header information) in the high speed memory buffer of the download module 220.

Therefore, Applicants submit that there exists support in the specification for claims 111 and 112 and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for these claims.

Regarding claim 113, it has been previously amended for clarification to recite “enables said selection only after all the digital data content of a particular program available for selection is received by the viewer.” Applicants apologize for providing the incorrect page and line number for this support previously. Support for this claim exists throughout the specification, and particularly on page 37, line 25 to page 38, line 1, which state “The customer therefore, at all times has immediate on-demand access to the movies in his storage module for viewing or permanent recording.” Thus, in the particular example provided in the specification above, a movie is available for selection for permanent recording only once all of its content has been received and is in the storage module.

Therefore, Applicants submit that there exists support in the specification for claims 113 as amended and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for this claim.

Regarding claims 116-118, they have been either previously (or currently amended herein with respect to claim 118) to address the inconsistency noted in the Office Action by adding the “link to” language and therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for these claims.

Regarding claim 120, it has been amended for clarification to recite “said selection is for permanent recording and is made only after all of said digital data content of a particular program is received at the location of the viewer.” Applicants apologize for providing the incorrect page and line number for this support previously. Support for this claim exists throughout the specification, and particularly on page 37, line 25 to page 38, line 1, which state “The customer therefore, at all times has immediate on-demand access to the movies in his storage module for viewing or permanent recording.” Thus, in the particular example provided in the specification above, a movie is available for selection for permanent recording only once all of its content has been received and is in the storage module.

Therefore, Applicants submit that there exists support in the specification for claims 120 as amended and respectfully request withdrawal of the rejections under 35 U.S.C. § 112 for this claim.

Rejections under 35 USC § 102

Claims 56, 107, 111, 119, and 120 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,619,247 to Russo.

Regarding claim 56, the Office Action states “Russo teaches transmitting movies and music selections to customers... and automatically recording a movie.” However, claim 56 recites “automatically selecting desired digital data content from the digital data content received.” In contrast, Russo describes automatic recording based upon a particular time a movie is to be transmitted according to future schedule information, rather than based upon digital data content actually received. (Col. 9, lines 38-51). In response to this, the Office Action admits on page 2 that “Russo teaches automatically selecting digital content (according to future schedule information)....,” and argues that “it cannot be stored until the content is transmitted and stored.” Applicants agree that content cannot be stored until it is transmitted, however, Applicants are not submitting that the content is stored before it is transmitted, but that according to claim 56, the automatic selection takes place *after* the content is received, rather than “according to future schedule information,” as the Office Action admits Russo does. It is important to note here that there is a distinction between the receiving of the content and the selection of the digital content. Claim 56 recites “transmitting digital data content to the viewer,” some of which may not have been selected, and then “automatically selecting desired digital data content from the digital data content received.” In Russo, the content is selected “according to future schedule information,” as the Office Action admits, and then at the scheduled time, the recording device tunes to the correct channel for the desired content and records it.

U.S. Pat. No. 4,908,713, for example, discloses hardware and methods which may be used in conjunction with this invention for the purposes of selecting such information for transfer to a future record memory 156 which, in conjunction with real-time clock 157 will enable the automatic and unattended recording of a desired program.

Russo, Col. 9, lines 45-51.

Thus, in Russo, the system never receives (i.e., records) the content that was not selected, and hence does not automatically select desired digital data content “*from* the digital data content received.” (emphasis added). Therefore, for at least the reasons above, Applicants submit that all the limitations of claim 56 are not taught or suggested by Russo.

Regarding claims 56 and 107, the Office Action states “Russo teaches downloading programs upon initial availability of a first-run movie.” However, claim 107 recites a mechanism that “automatically selects from the digital data content for storage in a memory randomly on a periodic basis.” Applicants respectfully submit that downloading upon initial availability of a first-run movie is not randomly. In response to this, the Office Action contends on page 3 that “from the point of view of the user, the sending of the first run movie is random in that random is lacking a definite plan, purpose, or pattern.” Applicants respectfully disagree. Even using the definition of random offered in the Office Action (which is not necessarily adopted by Applicants), downloading upon initial availability of a first-run movie does have a definite plan, purpose or pattern in that the plan or purpose is to only download first-run movies. Thus, for at least the reasons above, Applicants submit that all the limitations of claim 107 are not taught or suggested by Russo.

Regarding claim 119, the Office Action states “...the claim does not positively recite the broadcasting of the content before selection. Consequently, any transmitter that transmits content and the user does not select the content reads on ‘capable of transmitting...’.” Claim 119 has been amended herein to recite “configured to transmit...,” as opposed to “capable of transmitting, thus Russo does not describe such a transmitting mechanism.

Also, the Office Action on page 3 contends that “in order to store the content in Russo the data is clearly transmitted...” Applicants agree that in order to store the content in Russo, the data is first transmitted. However, Applicants submit that “storage” does not equate to “selection,” and claim 119 recites “transmit the digital data content to the viewer before *selection* of desired content for storage at a location of the viewer.” (emphasis added). Clearly, a selection can be made before transmission, as is described in Russo. Particularly, Russo does not describe the actual data content for storage being transmitted until after the selection (automatic or otherwise) of the content for future storage Col. 9, lines 46-51. Russo states “Yet a further option is for selections to be automatically downloaded based upon what has been previously viewed...” Col. 10, lines 4-5. Thus, in Russo, the automatic selection is made (based on previous viewing) and then the content is downloaded based upon that selection. In contrast, Claim 119 as amended recites “...transmit the digital data content to the viewer before selection of desired content for storage at a location of the viewer.” Thus, for at

least the reasons above, Applicants submit that all the limitations of claim 119 are not taught or suggested by Russo.

Therefore, for at least the reasons above, Applicants request the rejections of claims 56, 107, 111, 119, and 120 under 35 U.S.C. § 102(b) be withdrawn.

Rejections under 35 USC § 103

Claims 30-39, 41-50, 57, 60-64, 108, and 112-118 are rejected under 35 U.S.C. § 103(a).

Regarding claim 30, it is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of WO 92/22983 to Browne et al. (Browne). The Office Action states that Russo describes “communicating the movie selection to a program provider..wherein the program provider also bills the customers for the recorded selections and movies that actually played.” However, this communicating of the playing of the movie selection is communication the playing of the movie from the “program storage unit,” of Russo (Col. 5, lines 4-7). Russo does not describe communicating this information “to verify that that selected digital data content has been displayed from any *separate storage unit*.” (emphasis added), which claim 30 recites as amended herein. Support for this amendment appears throughout the specification and particularly on page 35, lines 16-22. Browne describes using a VCR as separate storage for video data, but also does not describe communicating any playback information “to verify that that selected digital data content has been displayed,” either. Thus, for at least the reasons above, Applicants submit that all the limitations of claim 30 are not taught or suggested by either Russo or Browne.


Claims 31-39, 41-50, 57, 60-64, 108, and 112-118 either depend directly or indirectly from claim 30, or with respect to claims 57 and 108, were rejected for the same reasons as claim 56 with respect to the element relating to “automatically selecting desired digital data content from the digital data content received...” Thus, Applicants submit that all the limitations of claims 31-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo for at least the same reasons presented above for claim 30 and/or claim 56. Therefore, Applicants respectfully submit that all the limitations of claims 31-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo, Browne, the other reference cited by the Office Action, or any combination thereof, for the same reasons presented above for claim 30.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 30-39, 41-50, 57, 60-64, 108, and 112-118 are not taught or suggested by Russo, Browne, the other references cited by the Office Action, or any combination thereof, for at least the reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) is earnestly solicited.

CONCLUSION

Applicants believe that the present reply is responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 30-39, 41-50, 56, 57, 60-64, 107, 108 and 111-120 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for the Examiner's continued rejection in light of the Applicant's arguments presented herein. Specifically, should the Examiner find the claims presented herein not to be allowable, Applicant's undersigned representative would respectfully request the Examiner to point Applicants to the column and line numbers in Russo where a viewer selects desired digital data content from the digital data content actually received by the viewer, as opposed to selecting from a schedule of future shows received by the viewer. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

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